



REMARKS

Reconsideration of this application is respectfully requested in view of the following remarks.

By this response, no claims have been amended. No new matter has been added. Claims 14-21, 35-42 and 55-58 are withdrawn. Thus, claims 1-6, 8-13, 22-27, 29-34, 43-54 and 59-62 are pending in this application and subject to examination.

Claims 1-6, 8-13, 22-27, 29-34, 43-54, and 59-62 are in Compliance with 35 U.S.C. § 112, 1st Par.

Claims 1-6, 8-13, 22-27, 29-34, 43-54, and 59-62 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Applicants respectfully traverse this rejection, as follows.

In making the rejection, the Office Action takes the position that "since word processor software is the most common method for creating electronic books and the applicant has provided evidence in their arguments that they are not aware of this, then the applicant must be less than ordinary skill in the art and is therefore [sic] cannot gain the benefit of this assumption." See Office Action, at page 4.

The Applicants submit that this position, even if it were to be true, which the Applicants do not admit, is insufficient to support a rejection under 35 U.S.C. §112. The first paragraph of 35 U.S.C. § 112 provides that "The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable **any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same."**

(emphasis added). This requirement is more specifically defined in the M.P.E.P. which provides, “An objective standard for determining compliance with the written description requirement is, ‘does the description clearly allow **persons of ordinary skill in the art** to recognize that he or she [the inventors] invented what is claimed.” See M.P.E.P. § 2163.02.

M.P.E.P. § 2163.04 provides that, in order to make a rejection for inadequate written description, “[t]he Examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant’s disclosure a description of the invention defined by the claims.” Here, the Office Action takes the position that “the applicant must be less than ordinary skill in the art,” and “cannot gain the benefit of this assumption.” The Applicants respectfully submit that such an assertion is not a proper basis for rejection under 35 U.S.C. § 112. The determination of whether a claim may be rejected under 35 U.S.C. § 112 is unrelated to the Applicants’ skill level, and therefore the Examiner’s statement is irrelevant to this determination. The test, as clearly defined in the statute and the M.P.E.P., is whether a person skilled in the art would be able to make and use the invention. The Applicants respectfully submit that the Office Action has failed to meet its initial burden of showing that this condition is not met.

Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 112 is respectfully requested.

Claims 1-6, 8-13, 22-27, 29-34, 43-54, and 59-62 Recite Patentable Subject Matter

Claims 1-6, 8-13, 22-27, 29-34, 43-46, 49, 51-54, and 59-62 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,850,629 to Holm et al. (hereinafter “Holm”) in view of “Mastering WORDPERFECT® 5.1 & 5.2 for Windows” by Simpson (hereinafter “Simpson”). Claims 47, 48, and 50 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Holm in view of Simpson and Dictionary, and further in view of Fawcett (U.S. Patent No. 5,802,526). The Applicants hereby traverse the rejections, as follows.

The Office Action admits that neither Holt nor Simpson teach or suggest the use of an electronic book system. The Office Action maintains that these elements are obvious. For example, with respect to claim 1, col. 10, lines 29-32 of Holm are cited as allegedly teaching “selecting an electronic book for viewing from a list of available books.” See Office Action, page 5. The cited lines of Holm disclose, “If sufficient memory is available, an entire text, such as a book, could be loaded into the local buffer. Typically, this would not be necessary as the context of the text can be discerned from less than the entire book.” See Holm, col. 10, lines 29-32. The Applicants submit that Holm does not teach or suggest at least this element of claim 1.

Nothing in the cited prior art, taken alone or in combination, discloses or suggests at least the combination of features of “selecting an electronic book for viewing from a list of available books; displaying a page of the selected electronic book on the viewer, the page including text; receiving a selection of text on the displayed page to be provided in audio; and providing at least a portion of the selected text in corresponding audio,” as

recited in method claims 1, 8, and 11, and in the parallel language of the corresponding apparatus claims 22, 29 and 32.

Nothing in the cited prior art, taken alone or in combination, discloses or suggests at least the combination of features of “selecting an electronic book for viewing from a list of available books on the screen; . . . and displaying a section within the screen for permitting the user to request a text-to-audio conversion of the identified text,” as recited in claim 43.

Nothing in the cited prior art, taken alone or in combination, discloses or suggests at least the combination of features of “a first section within the screen for selecting an electronic book for viewing; . . . and a third section within the screen for permitting the user to request a text-to-audio conversion of the identified text,” as recited in claim 51.

For at least these reasons, the Applicants submit that claim 1 is allowable over the cited prior art. As claim 1 is allowable, the Applicants submit that claims 2-6, and 59-60, which depend from allowable claim 1, are likewise allowable over the cited prior art.

For similar reasons to those provided with regard to claim 1, the Applicants submit that claims 8, 11, 22, 29, 32, 43, and 51 are each allowable over the cited art. As claims 8, 11, 22, 29, 32, 43, and 51 are allowable, the Applicant submits that claims 9-10, 12-13, 23-27, 30-31, 33-34, 44-50, 52-54, and 59-62, each of which depend from one of claims 8, 11, 22, 29, 32, 43, or 51, are each likewise allowable.

With regard to each of the rejections under §103 in the Office Action, it is also respectfully submitted that the Examiner has not yet set forth a *prima facie* case of obviousness. The PTO has the burden under §103 to establish a *prima facie* case of

obviousness. *In re Fine*, 5 U.S.P.Q.2nd 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. *Id.* In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998); *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999); *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

The Office Action merely states that it would have been obvious for a person having ordinary skill in the art at the time the invention was made, "that the input could come from 'pages' of an 'electronic book' because a word processor is capable of displaying text in a page format." See, e.g., Office Action at page 6. As argued before, the Applicants again submit that this general motivation statement is based on hindsight, and is therefore an insufficient showing of motivation. In response to the Applicants' arguments, the Office Action points out that "It is simply not believable that one of ordinary skill in the art would suffer such acute ignorance that they would not know that text could include pages of an electronic book." See Office Action, page 9. However,

this blanket statement of the Examiner's assumptions merely reinforces the Applicants' position that the motivation cited by the Examiner is a general motivation statement, and that the only way the references could have been combined and modified to teach the elements of the claimed invention is to use the Applicants' disclosure as a blueprint, which is the definition of hindsight reasoning and thus impermissible under M.P.E.P. § 2145(X)(A).

Accordingly, the Applicants submit that a prima facie case of obviousness has not been properly established. Reconsideration and withdrawal of the rejections is respectfully requested.

Applicants respectfully submit that this application is in condition for allowance and such action is earnestly solicited. If the Examiner believes that anything further is desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below to schedule a personal or telephone interview to discuss any remaining issues.

In the event that this paper is not being timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to Counsel's Deposit Account Number 01-2300, referencing Docket Number 026880-00014.

Respectfully submitted,



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